

AF 2604  
#3749  
#35

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Reissue Application of:

Willibald KRAUS

Serial No.: 08/230,083

Group Art Unit: 2604

Filed: April 20, 1994

OCT 04 2000

Examiner: H. Joyce

For: CHECK VALVE ASSEMBLY

Attorney Docket No.: TRW 2 0136-4

Assistant Commissioner of Patents  
Washington, D.C. 20231  
Box APPEALS

APPEAL BRIEF  
(SECOND SUBMISSION)

I. REAL PARTY IN INTEREST

The assignee of this application, TRW United-Carr GmbH and Co., KG is now TRW Automotive Electronics & Components GmbH and Co., KG. TRW Automotive Electronics & Components GmbH and Co., KG is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

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### III. STATUS OF CLAIMS

Reissue Application Claim 1	Pending	(Allowed)
Reissue Application Claim 2	Pending	(Allowed)
Reissue Application Claim 3	Pending	(Allowed)
Reissue Application Claim 4	Pending	(Allowed)
Reissue Application Claim 5	Pending	(Allowed)
Reissue Application Claim 6	Pending	(Allowed)
Reissue Application Claim 7	Pending	(Allowed)
Reissue Application Claim 8	Pending	(Allowed)
Reissue Application Claim 9	Pending	(Allowed)
Reissue Application Claim 10	Pending	(Allowed)
Reissue Application Claim 11	Pending	(Allowed)
Reissue Application Claim 12	Pending	(Allowed)
Reissue Application Claim 13	Pending	(Allowed)
Reissue Application Claim 14	Pending	(Rejected under "Recapture Rule")
Reissue Application Claim 15	Canceled	
Reissue Application Claim 16	Pending	(Rejected under "Recapture Rule")

The original application as filed on January 17, 1991 had fourteen (14) claims. Claims 2, 6, and 12-14 contained allowable subject matter as filed. More particularly, claims 2, 6, and 12-14 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 12 were canceled by way of an amendment filed on September 10, 1991. Claims 15 and 16 were added by way of the amendment filed on September 10, 1991. Claim 15 was, essentially, claim 2 rewritten into independent form to include the limitations of base claim 1. Claim 16 was, essentially, claim 12 rewritten into

independent form to include the limitations of base claim 1 and intervening claims 10 and 11. Original claim 1 was canceled by way of an Examiner's Amendment on November 8, 1991. The original application issued as U.S. Patent No. 5,105,731 on April 21, 1992. Pending claims 3-11 and 13-16 were renumbered as claims 1-13 in U.S. Patent No. 5,105,731.

The instant reissue application was filed on April 20, 1994. The reissue application maintained claims 1-13 from the '731 patent and added new claims 14-16. Claim 15 was canceled by way of an amendment filed on August 15, 1995 in the reissue application. Claims 1-14 and 16 were allowed in a Notice of Allowability mailed on November 6, 1996.

In a Letter from the Office of Patent Publication mailed March 11, 1998, the reissue application with allowed claims 1-14 and 16 was indicated as being withdrawn for consideration of Quality Review's determination that the claims are not subject to reissue since recapture exists. The Notice indicated that the withdraw was requested by the Group Director.

In an Office Action subsequent to the Notice mailed on April 9, 1998 the Examiner indicated that the scope of claim 14 differs from that of originally filed claim 1 in the original application and does not appear to be broader in any aspect than original claim 1. According to the Examiner in the Notice of April 9, 1998, claim 14 in the reissue application does not violate the recapture rule. Claim 16 was rejected under the equitable "Recapture" Doctrine.

In a subsequent Office Action mailed October 2, 1998 the Examiner reversed his position with regard to the indicated allowability of claim 14.

According to the above, therefore, claims 1-14 and 16 are pending in the instant reissue application.

Reissue application claims 1-13 are pending and stand allowed. Reissue application claims 14 and 16 are pending and stand rejected only under the equitable "Recapture" Doctrine. Reissue application claim 15 is

canceled.

#### IV. STATUS OF AMENDMENTS

A statement of the status of any amendment(s) filed subsequent to final rejection is as follows below.

Applicant has located and identified the most recent Final Rejection in the instant Reissue Application. In Paper Number 30 mailed from the U.S. Patent and Trademark Office on November 9, 1999, the Examiner identified the Action as "Final".

Subsequent to Paper Number 30, applicant filed a Notice of Appeal on May 8, 2000 together with a Request for Extension of Time. No claim amendments were tendered in either the Notice of Appeal or in the Request for Extension of Time.

Applicant's representative conducted a telephonic interview with Special Program Examiner Sholl on June 7, 2000. An Interview Summary Record memorializing the telephonic interview was mailed from the Patent Office on June 9, 2000 and identified as Paper Number 33. No claim amendments were made during the telephonic interview.

Applicant filed an Appeal Brief on July 10, 2000. There were no claim amendments contained in the Appeal Brief. Accordingly, there were no claim amendments after the Final Rejection.

#### V. SUMMARY OF INVENTION

The invention is directed to a check valve assembly. The invention has application in connection with ventilation systems for passenger spaces in motor vehicles. In the art, the present is known as a pressure relief valve (PRV). The overall construction of the subject device is described on pages 1-6 of the specification and shown in FIGURES 1-8.

One particular embodiment of the invention (CLAIM

14) is shown in detail in Figures 6, 7, and 8 of the application and described at page 6, line 34 to page 8, line 10. With reference to those figures and with additional reference to Figures 1-5, the present check valve assembly (1, Figs. 1 and 2) is adapted for use with a ventilation system (2, Fig. 1) for a passenger space of a motor vehicle. The assembly includes an outer housing (3, Fig. 1) having an open end and a surrounding wall (14, Figs. 1 and 6). An inner frame (4, Figs. 1-6) is received in the open end of the outer housing. A check valve element (5, Figs. 1 and 5) formed of a flexible sheet of material is clamped between the outer housing and the inner frame. In addition, first and second resilient clip connections (6, Fig. 1) joins the outer housing, the inner frame, and the check valve element to a support (2, Fig. 1) of a motor vehicle. The first clip connection includes a first spring tongue (6, Figs. 6-8) spaced from the surrounding wall. The second clip connection includes a second springy tongue (6, Fig. 1) integral with the surrounding wall.

In another embodiment shown in Figures 9-11 and described at page 8, line 11 to page 9, line 6, a check valve assembly (1, Figs. 1 and 2) includes an outer housing (3, Fig. 1) having an open end. An inner frame (4, Figs. 1-6) is received in the open end. A check valve element (5, Figs. 1 and 5) formed of a flexible sheet of material is clamped between the outer housing and the inner frame. A resilient clip connection (22', Figs. 9-11) is provided and formed separate from the outer housing (3, Fig. 1) and carried on a locking element (30, Figs. 9-11) which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

## VI. ISSUES

A concise statement of the issues presented for

review is as follows below.

1) whether independent claim 14 newly added in the instant reissue application violates the Recapture Rule; and,

2) whether independent claim 16 newly added in the instant reissue application violates the Recapture Rule.

#### VII. GROUPING OF CLAIMS

Applicant contests the ground of rejection which applies to a group of two or more claims including claims 14 and 16.

Applicant submits that the claims of the group, i.e. claims 14 and 16 do not stand or fall together.

Applicant respectfully submits that the claims of the group of rejected claims are separately patentable because claim 14 is directed to the clip connection embodiment shown in Figures 6, 7, and 8 of the specification and claim 16 is directed to the clip connection embodiment shown in Figures 9, 10, and 11.

#### VIII. ARGUMENT

There are no rejections under 35 U.S.C. §112, first paragraph.

There are no rejections under 35 U.S.C. §112, second paragraph.

There are no rejections under 35 U.S.C. §102.

There are no rejections under 35 U.S.C. §103.

As indicated above, claims 14 and 16 were rejected as being unpatentable under the equitable "Recapture" doctrine which prevents a reissue applicant from obtaining subject matter surrendered in an attempt to obtain allowance of the original patent claims. Applicant submits herewith a specification of the errors in the Examiner's rejection and other reasons which cause the rejection to be in error.

More particularly, and with reference now to the

latest Office Action mailed November 9, 1999 in connection with the instant reissue application, the Examiner rejected claim 14 and indicated that its scope differs from that of originally filed claim 1 by specifying that there are two clip connections, one of which comprises a springy tongue and is spaced from the surrounding wall, and the other of which comprises a springy tongue which is integral with the surrounding wall. The Examiner took the position that the change in scope recited in claim 14, even though narrower than the originally filed claim 1, is merely an obvious duplication of parts which is an unpatentable limitation. Accordingly, the Examiner was of the opinion that reissue claim 14 violates the recapture rule.

With regard to independent claim 16, the Examiner took the position that the claim adds no limitations to what was recited in originally filed claim 1 and, thus, violates the recapture rule as well.

Under the heading "Response to Arguments" in the Office Action, the Examiner stated that "[a]pplicant is erroneously taking the position that under In re Clement, the surrendered subject matter should be that subject matter added to cause the claim to be patented". In addition, the Examiner stated that "notwithstanding the fact that claim 16 recites additional limitations not present in originally filed claim 1, applicant is prohibited from removing the limitation that caused claim 1 to be patented in this reissue application". The Examiner referred applicant to In re Clement at page 116 that "[E]ven with the additional limitations, claims 50-52 are also broader than they are narrower in a manner directly pertinent to the subject matter that Clement surrendered during prosecution."

Applicant respectfully disagrees with the above, in particular, applicant respectfully disagrees with the Examiner's position set out under "Response to Arguments".

Applicant is not removing limitations that caused claim 1 in the original application to be patented. Rather, as noted above, independent claim 1 of the original

application was never itself patented or amended in any way to become patented. Instead, original claims 2 and 12-14 contain allowable subject matter as filed. The Examiner therefore merely objected to those claims in the Office Action mailed May 17, 1991, and indicated those claims as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. In response to the initial Office Action of May 17, 1991, applicant canceled original allowable claims 2 and 12 and rewrote them into independent form as new claims 15 and 16, respectively.

Essentially, applicant never amended independent claim 1 in the original application in order to secure allowance thereof. Rather, applicant merely canceled the rejected claims and rewrote the allowable claims into independent form to include all of the limitations of the base claim and any intervening claims.

**Claim 14 is Allowable:**

According to MPEP §1412.02, the Patent Office is now following the decision laid down in In re Clement 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) for guidance in determining whether reissue claims violate the recapture doctrine. The guidelines are as follows:

The first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitations aspect ... courts must determine in which aspects the reissue claim is broader, which include broadening as a result of an omitted limitation ...

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.



Further in accordance with MPEP §1412.02, criteria is identified for determining that subject matter has been surrendered. That criteria is as follows:

If the limitation now being omitted or broadened in the present reissue was originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application, the omitted limitation relates to subject matter previously surrendered by applicant, and impermissible recapture exists.

In order to best help facilitate an analysis of claim 14 using the above guidelines, applicant has prepared Table I below illustrating the differences between original application claim 1, patent claim 1, and reissue claim 14. As can be seen below in the Table, reissue claim 14 is broader than patent claim 1 in the "aspect" that the reissue claim 14 does not include the limitation of "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)".

Further in accordance with In re Clement, applicant respectfully submits that the second step recited there in applying the recapture rule is "to determine whether the broader "aspects" of the reissue claims relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claim 1 was canceled and original application claim 2 was rewritten into independent form as new claim 15

to include all of the limitations of claim 2 and base claim 1 as filed. Accordingly, although applicant does not admit to any surrendered subject matter in the instant Appeal, for the sake of argument, the only subject matter that could be considered to have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed. Original application claim 1 is repeated below in Table I.

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, applicant respectfully submits that the broader aspects of the reissue claim 14, namely the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution. As shown above, "surrendered" subject matter could only have been derived from the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the rim, rib member and stay limitations, these broader aspects of reissue claim 14 do not relate to the "surrendered" scope of original application claim 1.

With further reference to In re Clement, once it is determined that an applicant has surrendered the subject matter of the canceled or amended claim, it is next appropriate to determine whether this surrendered subject matter has crept into the reissue claim. As noted in In re Clement, "[c]omparing the reissue claim with the canceled claim is one way to do this."

Accordingly, applicant respectfully refers the Board to Table I below which compares the reissue claim 14 with canceled original application claim 1. As can be seen from the Table below, the "surrendered" subject matter of

canceled original application claim 1 has not crept into the reissue claim 14 because the reissue claim 14 includes additional limitations above and beyond those presented in original application claim 1. In particular, the limitation that the outer housing, the inner frame, and the check valve element are joined by "first and second resilient clip connections" to hold the outer housing, inner frame, and check valve to a support of a motor vehicle. Further, the "first clip connection comprises a first springy tongue spaced from the surrounding wall, and the second clip connection comprises as second springy tongue integral with the surrounding wall".

For at least the above reason, applicant respectfully submits that the "surrendered" subject matter of original application claim 1 has not crept into the reissue claim 14.

With yet further reference to In re Clement, the following principles are articulated to determine whether the recapture rule is applicable:

1. If the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim;
2. If it is narrower in all aspects, the recapture rule does not apply, but other rejections are possible;
3. If the reissue claim is broader in some aspects, but narrower in others, then;
  - (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; and,
  - (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible.

In application of the above principles as set forth in In re Clement, it is important to ascertain "aspects germane to the prior art rejections" when the reissue claim is broader in some aspects than the canceled or amended claim but narrower in others.

To that end, applicant respectfully repeats the initial Examiner's Action mailed May 17, 1991 in the original patent application for convenience of the Examiner here and with emphasis added to reinforce applicant's argument made below:

Claims 1, 3-5, and 7-11 are rejected under 35 U.S.C. § 103 as being unpatentable over either Feles, et al. or Frien in view of Mizusawa. Feles, et al. and Frien discloses the invention substantially as claimed. However, Feles, et al. and Frien do not disclose the resilient clip connection. Mizusawa shows a ventilator device for a vehicle. "When the side wall 17 is inserted through the mounting hole 27, the elastic pawl 23 and lock projection 24 of the side wall 17 engage with the edges of the hole, and the elastic pawl 23 is inwardly flexed as the side wall proceeds through the hole. Eventually, the bent rear end 27a of the door pillar defining the mounting hole engages with the elastic pawl 23 and lock projection 24, thus securing the ventilator device 15 in the mounting hole 27 of the door pillar P in co-operation with the rear end of the grille 18." (column 3, lines 34-48). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the flange of Feles, et al. or the front part of Frien with the elastic pawl 23 in Mizusawa in order to provide ease in mounting.

According to the above, "aspects germane to the prior art rejection" are those that relate to flanges, pawls, and other clip connection mechanisms or devices that provide ease in mounting the subject check valve assembly onto an associated support of a motor vehicle. No other aspects were discussed in the record that could be considered germane to the patentability of the rejected original

claims.

In the above respect, reissue claim 14 is narrower than both the original application claim 1 and patent claim 1 in that the clip connection is recited as including the limitation of "first and second resilient clip connections" joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle. Further, "the first clip connection comprises a first springy tongue spaced from surrounding wall, and the second clip connection comprises a second springy tongue integral with the surrounding wall." For this reason, applicant respectfully submits that reissue claim 14 is narrower than the canceled or amended claim in an aspect germane to the prior art rejection, namely, the aspect of the flange taught in the Feles, et al. prior art reference and the elastic pawl taught in the Mizusawa reference cited by the Examiner in the original Office Action, as those teachings relate to the scope of original application claim 1.

Further, applicant respectfully submits that reissue claim 14 is broader than the canceled or amended claim only in an aspect unrelated and not germane to the rejection in that the reissue claim 14 does not include the limitation of "the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9." The inner frame, rim and rib member limitations were not germane to the prior art rejection.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 14 is allowable and does not violate the Recapture Doctrine.

MPEP §1412.02 includes examples demonstrating where impermissible recapture exists. In Example "A", a limitation of the patent claims is omitted in the reissued claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. In this example, the omitted limitation was originally argued in the original application to make the application claims

allowable over a rejection or objection made in the application. Thus, according to this example, the omitted limitation relates to subject matter previously surrendered in the original application. In this example, MPEP §1412.02 makes it clear that the argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general "boilerplate" sentence will not be sufficient to establish recapture. An example of one such "boilerplate" sentence is "in closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims 1-7 are thus patentable. The MPEP makes it clear that in this example, this type of general "argument" will not, by itself, be sufficient to establish surrender and recapture.

In the case at hand, as noted above, applicant simply canceled allowable claim 2 and provided a new claim 15 which contained the essential features of allowable claim 2 and base claim 1. No argument was made on the record that any specific limitations were necessary in the claims to distinguish over the art of record. Applicant simply "took" the allowable claims.

In MPEP §1412.02 Example "B", the limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection made in the application. In this example, even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection.

In the case at hand, no additional limitations were added to the original application claims. Rather, newly added independent claim 15 contained the essential subject matter of allowable claim 2 and base claim 1.

In Example "C" for use in determining whether impermissible recapture exists, the limitation A omitted in

the reissue claims was present in the claims of the original application. The Examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. In this example "C" applicant did not present on the record a counter statement or comment as to the Examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

In the case at hand, in the original application, the Examiner provided no reasons for allowance with any indication that any particular limitation was necessary to distinguish the allowable claims over the potential combination of references.

**Reissue Claim 16 is Allowable:**

Once again, applicant respectfully submits that according to In re Clement, "[t]he first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims."

Accordingly, applicant has prepared Table II below illustrating the differences between patent claim 11 and reissue claim 16. As can be seen below in the Table, reissue claim 16 is broader than patent claim 11 in the "aspect" that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)".

Further in accordance with In re Clement, applicant respectfully submits that the second step recited there in applying the recapture rule is "to determine whether the broader "aspects" of the reissue claims relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claims 1 and 12 were canceled and original application claim 12 was rewritten into independent form as new claim 16 to include all of the limitations of base claim 1 and intervening claims 10 and 11 as filed. Accordingly, although applicant does not admit to any surrendered subject matter in the instant Appeal, for the sake of argument, the only subject matter that could have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed. Original application claim 1 is repeated below in Table II.

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, applicant respectfully submits that the broader aspects of the reissue claim 16, namely the absence of the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" does not relate in any way to any subject matter that could fairly be considered to be "surrendered" during prosecution. As shown above, "surrendered" subject matter could only have been derived from the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the dovetail guide limitation, this broader aspect of reissue claim 16 does not relate to the "surrendered" scope of original application 1.

With further reference to In re Clement, once it is determined that an applicant has surrendered the subject matter of the canceled or amended claim, it is next appropriate to determine whether the surrendered subject matter has crept into the reissued claim. As noted in In re Clement, "[c]omparing the reissue claim with the canceled claim is one way to do this."



Accordingly, applicant respectfully refers the Board to Table II below which compares the reissue claim 16 with canceled original application claim 1. As can be seen from the Table below, the "surrendered" subject matter of canceled original application claim 1 has not crept into the reissue claim 16 because the reissue claim 16 includes additional limitations above and beyond those presented in original application claim 1. In particular, the limitation of the resilient clip connection being "formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle."

For at least the above reason, applicant respectfully submits that the "surrendered" subject matter of original application claim 1 has not crept into the reissue claim 16.

Continuing on, applicant respectfully repeats here that based upon the initial Examiner's Action mailed May 17, 1991 in the original patent application, "aspects germane to the prior art rejection" are those that relate to flanges, pawls, and other clip connection mechanisms or devices that provide ease in mounting the subject check valve assembly onto an associated support of a motor vehicle. No other aspects were discussed in the record that could be considered germane to the patentability of the rejected original claim.

In the above respect, as shown in Table II below, reissue claim 16 is narrower than both the original application claim 1 and patent claim 11 in that the clip connection is recited as including the limitation of "securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." For at least this reason, applicant respectfully submits that reissue claim 16 is narrower than the canceled or amended claims in an aspect

germane to the prior art rejection, namely, the aspect of the flange taught in the Feles, et al. prior art references and the elastic pawl taught in the Mizusawa reference cited by the Examiner in original Office Action, as those teachings relate to the scope of original application claim 1.

Further, applicant respectfully submits that reissue claim 16 is broader than the canceled or amended claim in an aspect unrelated and not germane to the rejection in that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)." The locking element being guided over a dovetail guide on the outer surface of the outer housing limitations were not germane to the prior art rejection.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 16 is allowable and does not violate the recapture doctrine.

MPEP §1412.02 includes examples demonstrating where impermissible recapture exists. In Example "A" a limitation of the patent claims is omitted in the reissued claims. This omission provides a broadening aspect in the reissue claims, as compared to the claims of the patent. In this example, the omitted limitation was originally argued in the original application to make the application claims allowable over a rejection or objection made in the application. Thus, according to this example, the omitted limitation relates to subject matter previously surrendered in the original application. In this example, MPEP §1412.02 makes it clear that the argument that the claim limitation defined over the rejection must have been specific as to the limitation; rather than a general statement regarding the claims as a whole. In other words, a general "boilerplate" sentence will not be sufficient to establish recapture. An example of one such "boilerplate" sentence is "in closing, it is argued that the limitations of claims 1-7 distinguish the claims from the teachings of the prior art, and claims

1-7 are thus patentable. The MPEP makes it clear that in this example, this type of general "argument" will not, by itself, be sufficient to establish surrender and recapture.

In the case at hand, as noted above, applicant simply canceled allowable claim 12 and provided a new claim 16 which contained the essential features of allowable claim 12, base claim 1, and intervening claims 10 and 11. No argument was made on the record that any specific limitations were necessary in the claims to distinguish over the art of record. Applicant simply "took" the allowable claims.

In MPEP §1412.02 Example "B", the limitation omitted in the reissue was added in the original application claims for the purpose of making the claims allowable over a rejection or objection made in the application. In this example, even though applicant made no argument on the record that the limitation was added to obviate the rejection, the nature of the addition to the claim can show that the limitation was added in direct reply to the rejection.

In the case at hand, no additional limitations were added to the original application claims. Rather, newly added independent claim 16 contained the essential subject matter of allowable claim 12 and base claim 1 and intervening claims 10 and 11.

In Example "C", for use in determining whether impermissible recapture exists, the limitation A omitted in the reissue claims was present in the claims of the original application. The Examiner's reasons for allowance in the original application stated that it was that limitation A which distinguished over a potential combination of references X and Y. In this example "C" applicant did not present on the record a counter statement or comment as to the Examiner's reasons for allowance, and permitted the claims to issue. The omitted limitation is thus established as relating to subject matter previously surrendered.

In the case at hand, in the original application,

the Examiner provided no reasons for allowance with any indication that any particular limitation was necessary to distinguish the allowable claims over the potential combination of references.

#### IX. APPENDIX

Claims 1-13 stand allowed and are as set out in the Appeal Brief filed on July 10, 2000.

14. A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:

- an outer housing having an open end and a surrounding wall;

- an inner frame received in the open end;

- a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

- first and second resilient clip connections joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle, the first clip connection comprising a first springy tongue spaced from the wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

16. A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:

- an outer housing having an open end;

- an inner frame received in the open end;

- a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

- a resilient clip connection formed separate from the outer housing and carried on a locking element which is connected with the outer housing the clip connection

securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

# X. TABLES

TABLE I

Original Application Claim 1	Patent Claim 1	Reissue Claim 14
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	14. A <u>check valve assembly</u> adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end and a surrounding wall;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end;
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3); and,	first and second <u>resilient clip connections</u> joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle,
	wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).	
		the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

TABLE II

Original Application Claim 1	Patent Claim 11	Reissue Claim 16
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	11. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	16. A <u>check valve assembly</u> adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	a <u>resilient clip connection</u> (6) carried on the outer housing (3) and, wherein the clip connection (6) comprises a springy tongue (22')	a <u>resilient clip connection</u>
	<u>formed separate</u> from the outer housing (3), said springy tongue (22') being <u>arranged on a locking element</u> (30)	<u>formed separate</u> from the outer housing and <u>carried on a locking element</u>
	which can be <u>connected with the outer housing</u> (3), and	which is <u>connected with the outer housing</u>
	said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).	
		the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

**CONCLUSION**

In view of the above comments and arguments presented, applicant respectfully submits that reissue claims 14 and 16 are allowable under the Recapture Doctrine and in view of the references of record.

Claims 1-13 stand allowed.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP



*Michael E. Hudzinski*

Michael E. Hudzinski  
Reg. No. 34,185  
1100 Superior Avenue  
Seventh Floor  
Cleveland, Ohio 44114-2518  
(216) 861-5582

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I hereby certify that this **APPEAL BRIEF (SECOND SUBMISSION)** is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington, D.C. 20231, on September 29, 2000.

By: *Barbara J. Whaley*  
Barbara J. Whaley

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